

ESTTA Tracking number: **ESTTA175620**

Filing date: **11/19/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78832702
Applicant	Allegro Multimedia, Inc.
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Submission	Appeal Brief
Attachments	Appeal Brief.pdf ( 12 pages )(42007 bytes )
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Date	11/19/2007

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Allegro Multimedia, Inc.

Serial No. 78832702

Filed: 3/8/06

Mark: Wizard Tunes

APPEAL BRIEF

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## INTRODUCTION

Applicant Allegro Multimedia, Inc. has requested registration for the mark WIZARD TUNES for use as an on-line retail store services featuring downloadable pre-recorded music and video. The Examining Attorney, over the objection of Applicant's counsel, denied the registration due to the existence of the mark THE WIZ, which is registered for use as a retail store featuring audio and visual equipment, consumer electronics, computers, CD's, DVD's and appliances. Registration for Applicant's mark should be granted because there is no likelihood of confusion between Applicant's mark and the mark of THE WIZ, a non-objecting party to these proceedings.

## STATEMENT OF THE ISSUES

1. Did the Examining Attorney err in denying registration for Applicant's mark, WIZARD TUNES?

## RECITATION OF FACTS

Applicant applied for registration of the mark WIZARD TUNES on March 8, 2006. WIZARD TUNES is used in connection with on-line retail store services featuring downloadable pre-recorded music and video.

On July 16, 2006, the Examining Attorney issued an Office Action and refused to register the WIZARD TUNES mark due to Section 2(d) – Likelihood of Confusion. The Examining Attorney based her conclusion on the likelihood of confusion with two marks, U.S. Registration Nos. 1,204,052 and 1,893,461. The Examining Attorney explained her decision by stating “[a]ll the marks include the equivalent terminology “wiz” or “wizard” for retail outlets featuring audio and video products. See attached definitions. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 et seq.”

Registration Nos. 1,204,052 and 1,893,461 are both for THE WIZ. As provided by the Examining Attorney, the goods and services for which THE WIZ mark has been registered is “Retail Store Services for Audio and Visual Equipment,” as well as “retail store services in fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances.”

On January 16, 2007, Applicant responded to the Office Action and detailed the lack of confusion between the two marks. On February 8, 2007, the Examining Attorney issued an Office Action, making final the refusal to register the WIZARD TUNES mark based on Section 2(d) of the Trademark Act. The Examining Attorney found the likelihood of confusion between the WIZARD TUNES mark and the mark THE WIZ most convincing in the goods and services offered. In support of her position, the Examining Attorney stated “both parties sell to the general public pre-recorded movies and music.”

Applicant properly filed its Notice of Appeal on August 8, 2007. Applicant simultaneously filed a Response to the Office Action on August 8, 2007, requesting that the Examining Attorney reconsider the final refusal. Applicant’s Request for Reconsideration was denied by the Examining Attorney on August 28, 2007 and the final refusal was continued. Applicant’s Appeal Brief is timely filed.

### ARGUMENT

The Board reviews the decision of the Examining Attorney to determine if it was correctly made. TBMP § 1217. The Board’s determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties. *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

In considering the evidence of record on these factors, it should be kept in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”

*Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The mere fact that applicant's mark incorporates all the elements of the registered mark does not necessarily compel a finding that the two marks are confusingly similar. *See, e.g., New England Fish Company v. The Hervin Company*, 184 USPQ 817 (CCPA 1975) ("there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product mark"). Instead, "each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark." *Id.*

It is well settled that the issue of likelihood of confusion must be determined on the basis of the goods at issue as they are set forth in the involved application and the cited registration rather than in light of what the goods may actually be as shown, for instance, by extrinsic evidence. *See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

#### *The Word Marks Are Not Similar*

The Board should turn first to consideration of the marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). An analysis of the first *du Pont* factor requires the Board to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra.* Applicant's mark "WIZARD TUNES" is decidedly different from registrant's mark "THE WIZ". When viewed in its entirety, the fact that the first word of applicant's mark contains a portion of the second

word of registrant's mark cannot possibly justify a determination of similarity between the two marks. Although the word "tunes" has been disclaimed as descriptive, it still may be reviewed for the purposes of any allegations of a likelihood of confusion. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). As such, applicant's mark contains a distinguishing word – "TUNES" – which sets it even further apart from registrant's simple mark "THE WIZ".

It is well settled that marks must be considered in their entirety because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:41 (4th ed. 2001). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). It is not likely that the average consumer would see the mark WIZARD TUNES and confuse it with a mark that is as removed from it as THE WIZ. In the marketplace, a consumer will not likely engage in a drawn-out analysis of the etymology of the words. To a consumer, the relationship between the two marks would likely not arise to the level of acknowledgement; if it did, it would be a tenuous connection, at best.

There are recognizable differences in sound and appearance of the two marks. The marks begin with different words, and have a different number of syllables. Although not dispositive of the difference between the two marks, the sound and appearance of a mark contribute to the overall impression of the mark. *Palm Bay Imports, Inc., supra*.

When considering the marks in their entirety, the Board should also consider the dissimilarity between the words "WIZARD" and "THE WIZ". The use of identical, even dominant, words in common does not automatically mean that the two marks are similar.

*General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987). *See also ConAgra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368, 371 (8th Cir. 1993) (“We have stated that the use of dominant identical words in common does not mean the two marks are similar”). Despite the Examining Attorney’s assertion that one is simply an abbreviation of the other, there is no evidence presented that this is the case, or that a reasonable person, when viewing the two marks, could only believe that “THE WIZ” is merely an abbreviation of the word “WIZARD”. “THE WIZ” may be a reference to the book and movie *The Wizard of Oz*, the movie and musical *The Wiz*, or to an individual who contains a particular skill set at some activity (i.e. “a wiz kid”). Its use as an abbreviation for “wizard” is only one possible use in everyday language. As presented in evidence produced by the Examining Attorney, a WIZARD, unlike “THE WIZ”, is a magician.

The addition of other matter to one of two otherwise similar marks has been found sufficient to distinguish the marks as a whole under circumstances where: (i) there are recognizable differences in the asserted conflicting term [see, for example, *North American Corp. v. Eisenund Drahtwerk Erlau AG*, 176 USPQ 540 (TTAB 1973), *aff’d*, 182 USPQ 172 (CCPA 1974) (ERLAU ROCK-STANDARD not confusingly similar to ROCKWELL STANDARD)]; or (ii) the shared term is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for the same or related goods or services [see, for example, *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN’S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because “MENSWEAR” is merely descriptive of such services)]; or (iii) the marks in their entireties convey significantly different meanings or commercial impressions [see, for example, *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984) (HOBOS for restaurant services, suggesting a particular individual hobo named “Joe,” not confusingly similar to HUNGRY HOBOS for restaurant services, suggesting an anonymous person of that kind in need of a meal)]. Applicant’s mark conveys the commercial impression of a store that provides excellent or otherworldly music products. THE WIZ

mark, however, does not convey any particular commercial impression, and instead conveys a meaning more along the lines of a company that can get things accomplished well. Applicant's mark WIZARD TUNES conveys a significantly different meaning and commercial impression than THE WIZ mark, and, as such, there is no likelihood of confusion.

*The Marks Are Used For Dissimilar Goods And Services*

The second *du Pont* factor requires the Board to determine the similarity or dissimilarity of the goods as recited in the application and in the cited registration. Although the two marks do not need to be identical or competitive to find a likelihood of confusion, the goods or services must related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002). The issue isn't whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Even if the marks are identical, if these conditions do not exist, confusion is not likely to occur. *See, e.g., In re Unilever Limited*, 222 USPQ 981 (TTAB 1984); and *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983).

Both applicant's and registrant's identification of goods are narrowly worded and do not overlap, despite the contention of the Examining Attorney. THE WIZ specifically identifies its goods to be sold through "retail stores", whereas WIZARD TUNES identifies its sales to be done specifically through "on-line retail stores". Furthermore, in documents utilized by the Examining Attorney in support of her refusal, THE WIZ is described as selling "TVs, DVDs, VCRs, wireless, portable audio, cameras and camcorders, home office and computer products", as well as "purchase and self-install high speed cable

modems”. See Attachment 4, Office Action dated February 8, 2007. THE WIZ store also includes an area focusing on “youth athletic programs and related products.” *Id.*

The goods in the instant case have different uses and, just as important, may be used by different consumers. In general, not all consumers will purchase any items from the Internet. Out of the portion of the population which will make purchases on-line, only a percentage of those people will actually purchase downloadable media, including pre-recorded music and videos. There is a separate market for people who wish to purchase physical copies of pre-recorded music and movies. Of those people who wish to possess actual CDs and DVDs, some will choose to make those purchases online, whereas a larger number will visit a retail store and make their CD or DVD purchase there. Purchasers are not likely to assume that they are making a purchase of a physical CD when they are actually downloading a single pre-recorded song. As it stands, however, there is a vast difference in the consumer who makes a purchase from a website such as iTunes and the consumer who goes and buys a CD at Best Buy. The technological chasm between the two types of recordings – digital and physical – leads to a vast distinction in the consumer which uses each type of product. As such, the consumers who are utilizing applicant’s mark WIZARD TUNES will vary markedly from those utilizing the registrant’s mark THE WIZ. There should be no doubt that the source of these vastly different goods will not be confused.

*The Marks Utilize Separate Trade Channels*

The third *du Pont* factor requires the Board to determine the similarity or dissimilarity of the trade channels in which applicant’s and registrant’s respective goods are marketed. The Examining Attorney has argued that the goods are confusingly similar because “both parties sell to the general public pre-recorded movies and music.” What the Examining Attorney has failed to distinguish, however, is the form in which the goods are sold. Under its mark THE WIZ, registrant sells pre-recorded movies and music in the form of CDs and DVDs. Under its mark WIZARD TUNES, applicant will be selling pre-recorded videos and music in the form of *downloadable files from a computer*. The

distinction between these two mediums is enormous. To purchase an item from THE WIZ, the consumer can go to a physical brick-and-mortar store and pick out the CD or DVD they want. To then utilize the items purchased from THE WIZ, a consumer must place the CD in a CD player or the DVD in a DVD player. No computer is required for either item. To purchase any item from WIZARD TUNES, however, the consumer necessarily must first visit the website, on a computer. From there, the consumer will choose the pre-recorded music or movie to download directly onto their computer from the WIZARD TUNES website. These markedly different trade channels provide additional weight to applicant's position that there will be no likelihood of confusion between WIZARD TUNES and THE WIZ, and therefore WIZARD TUNES should be allowed registration on the Principal Register.

#### SUMMARY

For a likelihood of confusion analysis, the issue is whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). The average purchaser, when presented with the option of purchasing a CD or DVD at THE WIZ or downloading music or movies from WIZARD TUNES, will not encounter confusion between the two marks. Based on the complete lack of confusion between applicant's mark and registrant's mark, applicant respectfully

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requests that the decision of the Examining Attorney be reversed and that the mark WIZARD TUNES be allowed registration on the Principal Register.

DATED this 19<sup>th</sup> day of November, 2007.

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I hereby certify that the Appeal Brief was filed electronically via ESTTA on this 19<sup>th</sup> day of November, 2007.

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